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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,097	07/23/2003	Paul James Taysom	6647-049	8954
45842 7590 03/26/2007 MARGER JOHNSON & MCCOLLOM, P.C. - NOVELL 210 SW MORRISON STREET SUITE 400 PORTLAND, OR 97204			EXAMINER LY, CHEYNE D	
			ART UNIT 2168	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/26/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/626,097

Applicant(s)

TAYSOM, PAUL JAMES

Examiner

Cheyne D. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62 and 68-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62 and 68-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: 03/13 & 16/07
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Claims 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, and 68-70 are examiner on the merits.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, and 68-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 17, lines 6-7 recite "using the contract object to represent the relationship between the first object and the second object" and lines 14-17 recite "recording an entry...the entry recording the use of the contract object...removing the entry...after the contract object represents..." However, it is not clear as to whether the limitations recited in lines 8-13 drives the steps of "recording..." in lines 14-15 and "removing..." in lines 16-17, or the "using the contract.." (lines 6-7) step. It is noted that Applicant's interview summary, filed March 13, 2007, stating that the "entry could represent the manipulation of the objects, such was not required" further supports the ambiguity of the claim. Further, the specification on pages 8-9 does not make clear as to whether the "association...updating..." in lines 8-13 are related to the "recording an entry...and removing the entry." It noted that there are intermediates steps in the body of the claim which supports the claimed invention of "using a contract object." However, the claim, as a whole, does not clearly define the metes and bound of the claimed invention as

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readily understood by one of ordinary skill in the art. The same issue is present in claim 44.

Claims 18-24, 26-30, 32, 45, 46, 48, 49, 54, 60-62, and 68-70 are rejected for being dependent from claim 17 or 44.

6. Claim 17, line 12, recites the limitation of “at least one of the contract object” wherein the antecedent basis for said limitation is not clear. The limitation of “at least one of the contract object” suggests that more than one contract object has been recited previous to line 12.

However, line 1 specifically recites “a contract object.” The same issue is present in claim 44.

### **CLAIM REJECTIONS - 35 USC § 101**

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, and 68-70 are rejected under 35

U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. For example, claim 1 is directed to a method for using a contract object comprising the intermediate step of “updating...the contract object.” However, claim 1 results in “recording an entry in a transaction log, the entry recording the use of the contract object; and removing the entry from the transaction log after the contract object represents the relationship between the first object and the second object.” Therefore, the recording of an entry, and immediate removal of said entry does not produce any useful, concrete, and tangible result. It is noted that line 12 recites an intermediate step of “updating...of the contract object”, however, the claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at \*1373-74<, 47 USPQ2d at 1601-02. The same issue is present in claim 44.

### **Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. **Claims 17, 18, 20, 26, 44, 45, 60, 61, and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorur et al. (April 2003) (Gorur hereafter) in view of Iyengar (1999).**

### **MOTIVATION TO COMBINE**

13. Gorur describes an "invention relates generally to enterprise management, and more specifically to a system and method for improving collaboration between entities in a work environment" (page 1, [0006]) requiring software objects (page 2, [0026]). Iyengar describes "software caches are a critical component in improving the performance of many applications including Web servers, databases, and files systems" (page 329, column 1, Introduction section) by reducing overhead (page 329, column 2, lines 27-31) related to software objects. Therefore,

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one of ordinary skill in the art at the time of the invention would have been motivated by Iyengar to reduce overhead costs related to software objects of Gorur.

## **PRIOR ART**

14. In regard to claim 17, Gorur discloses a computer-implemented method for using a contract object (page 4, ([0051]), comprising:

Identifying first object (Figure 2, Item 202, and page 4, [0051]);

Identifying second object (Figure 2, Item 220, and page 4, [0051]);

Determining a relationship (page 4, [0051], especially, “details the relationships between contracts 210, contract system object group (CSOG)...”) between the first object and the second object;

using the contract object to represent the relationship between the first object and the second object (Figure 2, in its entirety);

associating a first rule with the contract object (page 5, [0073], especially, “rules 230 are also associated with contract object) the first rule including a first event that can occur to the first object and a first action (page 5, [0075]);

receiving the first event (page 5, [0075], especially, “entering or exiting”);

accessing the first rule associated with the contract object (page 5, [0076]); and

updating at least one of the contract object and the second object according to the first action responsive to the first event (page 6, [0081], especially, “modify the status of a contract...assess the full impact of the change on other contracts...All parties [second object] can then be notified automatically of the changes using predefined rules...”);

recording an entry in a transaction log, the entry recording the use of the contract object; (Figure 2, Item 240, page 2, [0034], especially, “a persistent dialog that records the communications...”, and page 5, [0074], especially, “dialog 240 includes Entry Person, Date Time, and Message attributes”).

15. However, Gorur does not describe the limitation of removing the entry from the transaction log after the contract object represents the relationship between the first object and the second object.

16. Iyengar describes the limitation of recording an entry in a transaction log, the entry recording the use of the contract object page 333, column 2, section 2.3, especially, “each read request generates a transaction record...”; and removing the entry from the transaction log after the contract object represents the relationship between the first object and the second object (page 330, column 2, section 2.1, especially, “after the expiration time for an object has passed, the object is no longer valid and can be deleted”). Therefore, it would have been obvious to one of ordinary skill in the art to modify the software objects of Gorur to reduce overhead costs as described by Iyengar.

17. In regard to claims 18 and 20, Gorur in view of Iyengar discloses the method comprising:  
Identifying a first objection includes identifying a plurality of first objects (Figure 2, especially, Items 222, 224, 226, and 228);  
Determining a relationship includes determining a plurality of relationships between each of the first objects and the second object (page 6, [0081, especially, “the interrelationships between contracts and contract participants”); and

Using the contract object includes using a plurality of contract objects to represent the plurality of relationships between the plurality of first objects and the second object (page 6, [0081, especially, “the interrelationships between contracts and contract participants”). Therefore, it would have been obvious to one of ordinary skill in the art to modify the software objects of Gorur to reduce overhead costs as described by Iyengar.

18. In regard to claim 26, Gorur in view of Iyengar discloses associating a second rule with the contract object, the second rule including a second event that can occur to the second object and a second action (page 4, [0050], “rules can be defined to produce an action upon the satisfaction of a condition...in the context of an event, such as entering or exiting” and “added or moved”). Therefore, it would have been obvious to one of ordinary skill in the art to modify the software objects of Gorur to reduce overhead costs as described by Iyengar.

19. In regard to claim 60, Gorur in view of Iyengar discloses receiving the second event (page 4, [0050], “added or moved”); accessing the second rule associated with the contract object (page 4, [0050], “rules can be defined to produce an action upon the satisfaction of a condition...in the context of an event, such as entering or exiting”); and updating at least one of the contract object and the first object according to the second action responsive to the second event (page 4, [0050], “a rule can be defined such that all contract participants are alerted when contract state machine 100 changes state...a participant is notified when they are added or removed as the provider or customer of a contract.” Therefore, it would have been obvious to one of ordinary skill in the art to modify the software objects of Gorur to reduce overhead costs as described by Iyengar.



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20. In regard to claim 61, as cited above, Gorur in view of Iyengar discloses rules as applied to the plurality of events. Therefore, the alerting when the contract state machine changes state as correspond to the added or removed event as been interpreted as “selecting the second rule from a plurality of rules based receiving the second event occurring to the second object” (participants). Therefore, it would have been obvious to one of ordinary skill in the art to modify the software objects of Gorur to reduce overhead costs as described by Iyengar.

21. In regard to claims 44, 45, and 68-70, Gorur in view of Iyengar discloses the computer readable medium (claim 30) for implementing the above cited method.

22. **Claims 19, 21-24, 27-30, 32, 46, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorur et al. (April 2003) (Gorur hereafter) and Iyengar (1999) as applied to claims 17, 18, 20, 26, 44, 45, 60, 61, and 68-70 above, and further in view of Yin et al. (US 2002/0091539) (Yin hereafter).**

#### **MOTIVATION TO COMBINE**

23. Yin describes “need exists for a method and a system to over come the...short coming of the prior art contract management system and provide a centralized contract system...a multilateral environment” (page 2, column 2, last 3 lines, to page 3, column 1, line 3). Gorur describes an “invention relates generally to enterprise management, and more specifically to a system and method for improving collaboration between entities in a work environment” (page 1, [0006]) requiring software objects (page 2, [0026]). Iyengar describes “software caches are a critical component in improving the performance of many applications including Web servers, databases, and files systems” (page 329, column 1, Introduction section) by reducing overhead

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(page 329, column 2, lines 27-31) related to software objects. Therefore, one of ordinary skill at the time of the invention would have been motivated by Gorur to improve the contract management Yin to overcome the short coming of the prior systems by reducing overhead costs as described by Iyengar.

#### **PRIOR ART**

24. In regard to claims 19, 21, and 46, Gorur in view of Iyengar describes all the limitations of said claims except for the limitations “each contract object represents the relationship between exactly one of the plurality of first objects and the second object.” Yin describes each contract object represents the relationship between exactly one of the plurality of first objects and the second object (Figure 9, especially, Contract class, ProviderAccountId (FK), ConsumerAccountID (FK), and ParentContractId(FK)) wherein the schema of Figure 9 represents the mapping between the contract object and the first and second objects. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the contract management system of Gorur and Iyengar with mapping described by Yin to overcome the short coming of the prior systems by reducing overhead costs as described by Iyengar.

25. In regard to claims 22, 23, 28-30, 48, and 49, Gorur in view of Iyengar describes all the limitations of said claims except for the limitations of locators and identifiers. Yin describes a Contract Object comprising locators and identifiers (Figure 9, especially, Contract class, ProviderAccountId (FK), ConsumerAccountID (FK), and ParentContractId(FK)). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the contract management system of Gorur with the locators and identifiers described

by Yin to overcome the short coming of the prior systems by reducing overhead costs as described by Iyengar.

26. In regard to claim 24, Gorur in view of Iyengar describes all the limitations of said claims except for the limitations “storing a metadata for the first object in the contract object.” Yin describes “storing a metadata for the first object in the contract object” (page 3, [0023], especially, “associates multiple sets of metadata elements...”, page 3, [0026], especially, “Partners add contracts, contract metadata...”, and Figure 12, especially, “CONTRACT METADATA”). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the contract management system of Gorur with the contract metadata described by Yin to overcome the short coming of the prior systems by reducing overhead costs as described by Iyengar.

27. In regard to claim 27, Gorur in view of Iyengar describes all the limitations of said claims. Further, Gorur describes a collection objection (page 4, [0055], especially, “the assignment of entire groups of users to activities and rules”, and [0061], especially, “Summary tasks are similar to projects as they represent a collection of smaller activities”). However, Gorur does not describe the limitation “a file object”. Yin describes a file object (page 12, [0233], especially, logical object containing the file name). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the contract management system of Gorur with a file object as described by Yin to overcome the short coming of the prior systems by reducing overhead costs as described by Iyengar.

28. In regard to claim 32, since the claim does not set forth any steps involved in the method as to “using the entry...” is actually practiced. Therefore, the limitation has been interpreted

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reasonably broad. Gorur describes “the persistent dialog can therefore represent an archive record of the contract negotiation process” (page 4, lines 1-4) wherein the dialog comprise “Entry Person, Date Time, and Message attributes” (page 5, [0074]). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use persistent dialog of Gorur to reconstruct a contract object to overcome the short coming of the prior systems as described by Yin and Iyengar by reducing overhead costs.

**29. Claims 54 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorur et al. (April 2003) (Gorur hereafter) in view of Iyengar (1999) and Yin et al. (US 2002/0091539) (Yin hereafter) and as applied to claims 17-24, 26-30, 32, 44-46, 48, 49, 60, 61, and 68-70 above, and further in view of Kulkarni (1995).**

#### **MOTIVATION TO COMBINE**

30. Yin describes “need exists for a method and a system to over come the...short coming of the prior art contract management system and provide a centralized contract system...a multilateral environment” (page 2, column 2, last 3 lines, to page 3, column 1, line 3). Gorur describes an “invention relates generally to enterprise management, and more specifically to a system and method for improving collaboration between entities in a work environment” (page 1, [0006]) requiring software objects (page 2, [0026]). Iyengar describes “software caches are a critical component in improving the performance of many applications including Web servers, databases, and files systems” (page 329, column 1, Introduction section) by reducing overhead (page 329, column 2, lines 27-31) related to software objects. While, Kulkarni describes a new approach to flexibility in system software (Abstract etc.) wherein contract objects are key to the

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new approach (page 54, section 4.1.1.5). Therefore, one of ordinary skill at the time of the invention would have been motivated by Gorur to improve the contract management Yin to overcome the short coming of the prior systems by applying the new approach of Kulkarni to reduce overhead costs as described by Iyengar.

### **PRIOR ART**

31. In regard to claims 54 and 62, Gorur in view of Iyenga and Yin describes the limitations of said claims. Further, Yin describes "a clause type is selected...equipment update clause..." (page 13, [0245]) wherein "the metadata for association can include contract clauses..." (page 11, [0193]). However, Gorur in view of Iyenga and Yin does not describe the limitation of a rename event. Kulkarni describes a rename event such rename a file (page 85, Table 5.1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the rename event of Kulkarni to overcome the short coming of the prior systems to reduce overhead costs as described by Yin in view of Gorur and Iyengar.

### **CONCLUSION**

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Sakai (1993) for describing a method for contract design and delegation in object behavior modeling; and McBride (US 6,025,836A) for describing a method and apparatus for generating object oriented user interfaces.

33. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is

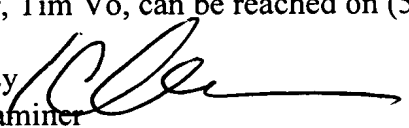
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(866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

34. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly   
Patent Examiner  
3/22/07